

REMARKS

Amendments to the Claims

Claims 1, 11 and 17 are amended, and finds support for the amendments throughout the specification and drawings as originally filed, including in Paragraph [0024] and Paragraph [0025].

Rejections Pursuant to 35 USC § 102

The Office rejects claims 1-6 and 10-20 as being anticipated by U.S. Patent No. 5,469,839 to Kasulis et al. (the “Kasulis patent”).

“Under 35 U.S.C. 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim.” *Gechter v. Davidson*, 116 F.3d 1454 (Fed. Cir. 1997) (emphasis added); *see also* MPEP § 706.02. In this regard, the Kasulis patent is not an anticipatory reference to the claims for several reasons.

For example, Claims 1, 11 and 17 all recite that the each light reflective material is measured to substantially fit within, and couple substantially parallel to, the interior surface structure of the firebox so that a three-dimensional view consistent with the pre-determined interior surface of the firebox is provided. In contrast, the Kasulis patent discloses a viewable surface 76 which has a separate and different angular surface plane than viewable surface 78 (*see* the Kasulis patent, Figure 8, where surface 78 is at approximately a 45 degree angle to surface 76). Indeed, the Kasulis expressly teaches away from the present invention, as it requires viewable surfaces which have “an orientation *offset* from the vertical within a fireplace” (*see* Abstract), so that the rear surface has a different angular position than the surface 78 (*see* Kasulis patent, Col. 5, l. 66 – Col. 6, l. 3). This is a very specific orientation which is contrary to the teachings of the present invention. Because of this very specific orientation, the Kasulis patent can never achieve reflective material which is substantially parallel to the interior surface of a firebox or fire chambers as recited by the present claims, thereby maintaining an optical view consistent with the predetermined interior surface of the fireplace, firebox or fire chamber. And again, the Kasulis patent’s the upper angled mirror “is set an at angle that reflects heat” (*see* Col. 7, l. 15-17), which is an entirely different purpose than that of the present invention.

In support of the Applicant’s position, attached as Exhibit A to this Response is the Affidavit Pursuant To 37 C.F.R. 1.132 of Dr. Yashvinder Sabharwal. Dr. Sabharwal is a person of significant experience in the field of optical sciences and optical engineering. Dr. Sabharwal testifies that the present claims “recite that the optical view by a viewer of the firelight in the fireplace or firebox will be different in accordance with the present invention when compared to the view created by the Kasulis disclosure. The Kasulis disclosure teaches the use of mirrors positioned at angles to the interior surfaces of the fireplace or firebox, which will create an optical view that is different in perspective from the original three-dimensional construction of the fireplace or firebox. (See e.g., Kasulis disclosure, Figs. 2, Col. 5, ll. 53 – 56; Fig. 8, Col. 5, ll. 59 – 62). Any images reflecting off the Kasulis patent surfaces (for example, surfaces 76,78 in the Kasulis disclosure Figure 8) would necessarily present an elongated optical image of the firelight to a viewer of the Kasulis invention. The present invention, in contrast to the Kasulis disclosure, teaches the positioning of the reflective material to be substantially parallel to the interior surfaces of the fireplace or firebox, maintaining an optical view consistent with the predetermined interior surface of the fireplace, firebox or fire chamber.” (citations omitted). As such, as a person highly skilled in the optical arts, Dr. Sabharwal provides further evidence supporting Applicant’s position that the present claims are not disclosed anywhere by the Kasulis patent, but rather, teaches away from the present invention.

Moreover, the rejected claims recite that the invention is “measured to substantially fit within, and couple

to, one or more interior surfaces of the fireplace.” There is absolutely no disclosure in the Kasulis patent that its surfaces “substantially fit” within the interior firebox because the Kasulis disclosure is expressly intended to have one of the major surfaces 68/78 be angled away from an interior surface of the firebox, and supported by brackets through a hinge, so that its angular position can be changed through a series of dials 44 (*see* Col. 5, ll. 51-57) for heat reflection (*see* Col. 7, l. 15-17). As such, the Kasulis patent expressly teaches away from the present invention.

Because the Kasulis patent fails to disclose every limitation of the present independent claims identically pursuant to 35 U.S.C. § 102, the Kasulis patent fails to anticipate the rejected independent claims (i.e., Claims 1, 11 and 17), and those claims which depend on these claims (i.e., claims 2-6, 8-10, 12-16 and 18-20).

Finally, the Office also states that the claims’ phrase “measured to substantially fit within, and couple to, one or more interior surfaces of the fireplace” is a recitation of intended use, and fails to impart a structural limitation to distinguish the claimed invention over the art of record. This statement is made in reference to the Section 102 rejection, and no other statutory rejection. As identified previously by the Applicant, Section 102 does not require any recitation of a structural limitation. As such, the Applicant finds it difficult to respond to the Office’s statement. Nevertheless, as illustrated above, the claims, as amended, already recite an invention that further distinguishes the present invention over the Kasulis patent. And, as long as those of ordinary skill in the art realize that the dimensions could easily be obtained for a firebox, the patent law does not require “that all possible lengths corresponding to the” dimensions found in all fireboxes made be listed in the specification, “let alone, they be listed in the claims.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565 (Fed. Cir. 1986). In the August 24 Office Action, the Office fails to mention, consider or even distinguish this mandate by the Court of Appeals for the Federal Circuit. Considering that the present invention concerns basic fireplaces which have existed for many, many years, the Applicant submits that those of skill in the art would understand the phrase “each light reflective material measured to substantially fit within, and couple substantially parallel to, any pre-determined interior surface structure of the firebox, the system adapted to provide a three-dimensional view consistent with the pre-determined interior surface of the firebox” as it applies to this invention, which is a functional limitation relative to the varying measurements found inside various-sized fireboxes.

Reconsideration is respectfully requested.

First Rejection Pursuant to 35 USC § 103

The Office, at page 9 of the Office Action, identifies a “Claim Rejections – 35 USC § 103” section, yet no claims are identified as being rejected under this heading. Instead, in this section, the Office advises that under 37 C.F.R. 1.56, when joint inventors are named, the Applicant has an obligation to point out the inventor and invention dates of each claim not commonly owned. Rule 1.56 does not contain such an express duty of disclosure of “each claim not commonly owned”. Moreover, in accordance with MPEP § 706.02(1)(2), the Office is not relying on (and has not found) any prior art which names the current inventors, so that this section of the office action is difficult to provide a response. Nevertheless, in Response, the Applicant expressly identifies that the named joint inventors (who are husband and wife) commonly own all pending claims.

Second Rejection Pursuant to 35 USC § 103

The Office rejects claims 8 and 9 as being unpatentable over the Kasulis patent in view of Japan disclosure 2003-79507 (the “Japan disclosure”).

In traversal, it follows that since Claim 8 is dependant upon Claim 3, Claim 3 is dependant upon Claim 1, and because the Office has not rejected Claim 1 under Section 103, then Claim 8 cannot be rejected under Section 103. Also, since Claim 9 is dependant upon Claim 3, Claim 3 is dependant upon Claim 1, and Claim 1 is not rejected under Section 103, then Claim 9 must similarly stand as not rejected under Section 103. As such, the Applicant cannot respond to the Office's Section 103 prior art reasoning and rejections because Claims 8 and 9 must stand as not being rejected, since they are dependant upon a non-rejected claim (Claim 1) pursuant to Section 103.

This position was expressly identified by the Applicant in its "Response to April 13, 2005 Office Action" (filed June 8, 2005) - the Office did not comment on this position in the August 24, 2005 Office Action. As such, it is deemed accepted by the Office.

Withdrawal of this continued rejection (without any further foundation from the Office to support this rejection) is respectfully requested.

Conclusion

In light of the foregoing amendments and remarks, the Applicant respectfully requests the Office to withdraw the pending objections and rejections, and allow the present application to issue. The undersigned would welcome a phone call from the Office to expedite the resolution of this application. A return postcard is attached, which the Applicant requests the Office to stamp and mail to the Applicant.

Respectfully submitted,

Date: December 23, 2005

By: Kevin Lynn Wildenstein
Kevin Lynn Wildenstein
Reg. No. 39,072

Southwest Intellectual Property Svcs., LLC
6700-B Jefferson NE, Suite 8
Albuquerque, New Mexico 87109
(505) 468-0555
Fax (505) 468-0556